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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/904,299 07/31/97 LUNDBERG

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QM01/0810

EXAMINER

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KAMEN, N

ART UNIT

PAPER NUMBER

20

3747

DATE MAILED: 08/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.	8904,299	Applicant(s)	Lundberg
Examiner	KAMEN	Group Art Unit	3747

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on 7/20/00.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Claim(s) 1-6, 9-12, 16-22 is/are pending in the application.

Of the above claim(s) 9, 17-22 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-6, 10-12, 15, 16 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-11, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grennan (fig.2). Grennan shows all of the recited elements except for the capacity of the generator 166. It would have been obvious to one of ordinary skill in the art to size the generator according to the supply system size and degree of peak capacity. Furthermore, the use of gauges, valves and appropriate controls are inherently necessary for the proper operation of Grennan.

### ***Response to Arguments***

3. Applicant's arguments filed 7/20/00 have been fully considered but they are not persuasive. The applicant argues that Grennan has a motor 166 which requires combustion for its operation. The examiner agrees that a motor is needed for the operation, but the motor could just as well be powered by batteries charged when the gas is expanded. Grennan is silent as to how the motor is powered.

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The applicant argues that Grennan teach (col.4, lines 11+) that combustion is carried out to increase the temperature of the fluid. The examiner argues that the embodiment of figure 2 does not require the combustion of gas.

The applicant argues that Grennan does not teach a method of generating power or a satellite assembly which requires the direct utilization of a portion of the gas ~~flowing~~ through the delivery conduit pipeline to a customer. Instead, Grennan discloses a co-generation scheme which utilizes the flow of gas between the high and low pressure systems, not the diversion of a portion of gas that is flowing through the low pressure delivery conduit pipeline to each customer. The examiner contends that Grennan clearly teaches (col.6, lines 38+) an arrangement where natural gas is transported at a high pressure over long distances and then reduced when it reaches its region of use and that there are a plurality of distribution lines (read satellites). Furthermore, if one of ordinary skill in the art did not require off peak energy storage, then the entire compression system could be removed. "It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before." In re Karlson, 136 USPQ 184.

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries concerning the examiner's action should be directed to Noah Kamen at (703) 308-1945. The supervisory examiner, Henry Yuen, can be called at 308-1946. Fax is 308-7764. Questions of a general nature concerning the application should be directed to the group receptionist at 308-0861.



NOAH KAMEN  
PRIMARY EXAMINER  
ART UNIT 3747

August 9, 2000